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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,076	12/31/2001	David Kaufman	KCC4803 (K-C No. 16,436)	9166

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SENNIGER POWERS LEAVITT AND ROEDEL  
ONE METROPOLITAN SQUARE  
16TH FLOOR  
ST LOUIS, MO 63102

EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 11/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/039,076

Applicant(s)

KAUFMAN ET AL.

Examiner

Rob Rhode

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 - 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The two claims refer to themselves and therefore are indefinite. For examination purposes, the two claims will be examined as depending from and referring to Claim 17. Applicant must make the appropriate corrections.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 13, 15 - 16 and 28 - 33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea [of providing, producing a product or tissue to order and customizing a product/tissue] mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter

to an otherwise abstract idea if the component does not affect or effect the underlying process. These claims do not fall within the technological arts because no form of technology is disclosed or claimed. For example, the applicant has not recited the use of a computer or related technology in these claims.

***Claim Rejections - 35 USC § 102***

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**Claims 1, 5, 8, 10 – 12, 14 and 28 - 33 rejected under 35 U.S.C. 102(a) as being unpatentable over “Who Wants To Market a Millionaire?” Rosenspan, Alan; Direct Marketing; March 2001; page 45 (hereafter referred to as Direct Marketing)**

Regarding Claim 1, Direct Marketing discloses a method of providing a consumer with a product, the method comprising - providing the consumer with a first list of options for a first feature of an absorbent paper product (Page 2, line 43), and a second list of options for a second feature of the absorbent paper product (Page 2, line 43); and receiving from the consumer a selection of one of the options from the first list (Page 2, lines 43 - 44), a selection of one of the options from the second list (Page 2, lines 43 - 44) and a purchase order for a particular absorbent paper product having the options selected by the consumer (Page 2, line 44); and delivering to the consumer the particular absorbent paper product having the options selected by the consumer (Page 2, lines 43 - 44).

Regarding Claim 5, Direct Marketing further discloses a method wherein the absorbent paper product is a facial tissue product, and wherein the first feature and the second feature are selected from the group consisting of tissue count, tissue style, tissue color, tissue scent, tissue graphic design (Page 2, line 43), tissue packaging style, tissue packaging color, and tissue packaging graphic design.

Regarding Claim 8, Direct Marketing discloses a method wherein the absorbent paper product is a facial tissue product, wherein the first feature is tissue graphic design (Page 2, Line 43), and wherein the second feature is tissue packaging graphic design (Page 2, line 43).

Regarding Claim 10, Direct Marketing discloses further comprising producing, in response to the receiving, a particular facial tissue product having the options selected by the consumer (Page 2, line 44).

Regarding Claim 11, Direct Marketing discloses a method of producing a product to order, the method comprising - collecting information from a consumer relating to one or more desired features of an absorbent paper product (Page 2, line 43); receiving a purchase order from the consumer for an absorbent paper product having the one or more desired features (Page 2, line 44); and producing the

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absorbent paper product having the one or more desired features in accordance with the information collected from the consumer (Page 2, lines 43 and 44).

Regarding Claim 12, Direct Marketing discloses a method wherein the absorbent paper product is selected from the group consisting of facial tissue, toilet tissue (Page 2, Lines 42 - 43), paper towel, napkin, and baby wipe products.

With regard to Claim 14, the recitation that "wherein collecting includes collecting the information from the consumer via a kiosk", such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patenatably distinguish the instant invention from the telephony network already disclosed by Forseth.

Regarding Claim 28, Direct Marketing further discloses a method of customizing an absorbent paper product for a consumer, the method comprising - receiving from the consumer a graphic design and a purchase order for a custom absorbent paper product embodying the graphic design (Page 2, line 43); and incorporating the graphic design received from the consumer into the absorbent paper product to thereby produce the custom absorbent paper product ordered by the consumer (Page 2, lines 43 and 44); and providing the custom absorbent paper product to the consumer (Page 2, line 42 - 44).

Regarding Claim 29, Direct Marketing discloses a method wherein the absorbent paper product is a facial tissue product including facial tissues and packaging for the facial tissues (Page 2, Lines 42 – 44), and wherein incorporating includes applying at least a portion of the graphic design received from the consumer to the facial tissues or the packaging for the facial tissues (Page 2, Line 43).

Regarding Claim 30, Direct Marketing discloses a method wherein receiving includes receiving a first graphic design and a second graphic design from the consumer (Page 2, Lines 42 – 43), and wherein incorporating includes printing the first graphic design on the facial tissues and printing the second graphic design on the packaging for the facial tissues (Page 2, lines 42 – 43).

Regarding Claim 31, Direct Marketing discloses a method wherein receiving includes receiving from the consumer a graphic design comprising text (Page 2, Lines 42 – 44).

Regarding Claim 32, Direct Marketing discloses a method wherein receiving includes receiving from the consumer a graphic design comprising a photographic image (Page 2, Line 44).

Regarding Claim 33, Direct Marketing discloses a method wherein receiving includes receiving from the consumer a graphic design comprising text (Page 2, Line 43).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2, 4, 6, 7, 13, 15 – 21 and 23 - 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Direct Marketing in view of Forseth et al (US 2002/0004749 A1).**

Direct Marketing discloses methods of selecting, customizing, receiving, producing and providing an absorbent paper product for a consumer.

Direct Marketing does not disclose specifics regarding a system to provide a communication network with associated server to collect information regarding product selections from a consumer and to produce the desired selection. Nor does Direct Marketing disclose, a method of producing a custom facial tissue product for a consumer based on the selection information collected from a consumer and the supporting communications network – as well as a production machine.



However Forseth while not disclosing specifically a system and methods for producing absorbent paper products, Forseth does teach regarding a system and methods for producing a selected product directly for a consumer. Moreover with respect to Claims 2, 4, 6 and 7, Forseth discloses a method for selecting first and second feature, wherein the first feature is for product packaging design and the information is received over a communications network (Figure 1).

Regarding Claim 2, Forseth discloses a method wherein the first feature and the second feature are selected from the group consisting of product count (Page 1, Para 0013, line 4), product style, product color, product scent, product graphic design, product packaging style, product packaging color, and product packaging graphic design.

Regarding Claim 4, Forseth discloses a method wherein the first feature is product packaging graphic design, and wherein the options for the product packaging graphic design include a predefined graphic design, no graphic design, and a graphic design supplied by the consumer (Page 1, Para 0013, Lines 6 – 8).

Regarding Claims 6 and 7, Forseth further discloses the method wherein the providing and the receiving are performed over a communications network (Figure

1); and wherein the communications network is a computer network or a telephony network (Figure 1).

With respect to Claims 13, 15 and 16, Forseth discloses a method wherein at least one feature is selected and includes collecting the information from a consumer through a communications network (Figures 1 and 2A).

Regarding Claim 13, Forseth discloses a method wherein at least one of said desired features is selected from the group consisting of product count (Page 1, Para 0013, Page 4), product style, product color, product scent, product graphic design, product packaging style, product packaging color and product packaging graphic design.

With respect to Claim 15, Forseth discloses a method wherein collecting includes collecting information from the consumer through a communications network (Figure 1).

With respect to 16, Forseth discloses a method wherein the communications network is a telephony network or computer network (Figure 1).

With respect to Claims 17 – 21 and 23, Forseth discloses a system for producing a product and the system comprises a communications network enabling the consumer to select a product as well as production machine in order to produce the selection -

and including a packager machine with associated printing machine (Figures 1 and 2A).

Regarding Claim 17, a system for producing a product comprising a network interface for receiving information from a consumer over a communications network (Figure 1), said information relating to one or more features of an absorbent paper product desired by the consumer, and a production machine configured to receive the information provided by the consumer over the communications network (Figures 1 and 2A), and configured to produce the absorbent paper product desired by the consumer based on said information (Figure 2A and Page 2, Para 0019).

Regarding Claim 18, Forseth also discloses the system further comprising a computer server operatively connected to the production machine and the communications network (Figure 2A), wherein the computer server is configured to receive said information from the consumer over the communications network (Figure 2A), and to provide said information to the production machine (Figure 2A).

Regarding Claim 19, Forseth discloses a system wherein the production machine is configured to automatically produce the absorbent paper product desired by the consumer in response to receiving said information from the computer server (Figure 2A).

Regarding Claim 20, Forseth further discloses a system wherein the production machine includes a packager configured to automatically package the absorbent paper product desired by the consumer (Figures 1 and 2A).

Regarding Claim 21, a system wherein said information includes information specifying a graphic design desired by the consumer, and wherein the production machine includes a printer for printing the graphic design on the absorbent paper product desired by the consumer (Page 10, Para 0116, lines 5 – 7).

Regarding Claim 23, Forseth discloses a system wherein the communications network is a telephony network or a computer network (Figure 1).

With respect to Claims 24 – 27, Forseth further discloses a method of producing a consumer product which includes receiving information, with the information relating to optional features – as well as a supporting communication network with associated computer server (Figures 1, 2A and 3A).

Regarding Claim 24, Forseth further discloses a method of producing a custom facial tissue product for a consumer, the method comprising - receiving information from the consumer over a communications network (Figure 1 and Figure 2A), said information relating to one or more optional features of the custom facial tissue product (Figure 1 and Figure 3A); providing said information to a production machine (Figure 1 and Figure 2A); and producing

the custom facial tissue product in accordance with the information received from the consumer and provided to the production machine (Figure 2A).

Regarding Claim 25, Forseth discloses a method wherein the communications network is a computer network, and wherein receiving includes receiving said information from the consumer over the computer network via a computer server (Figure 1).

Regarding Claims 26 and 27, Forseth discloses a method wherein the communications network is a telephony network, and wherein receiving includes receiving said information from the consumer over the telephony network via a telephone attendant (Page 7, Para. 0086, lines 22 – 24); and wherein said telephone attendant is an automated attendant (Page 7, Para 0086, lines 22 – 24).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided in the methods and system of Forseth with the methods of Direct Marketing to have included absorbent paper products such as facial tissue or toilet tissue in order to expand the types of consumer products available for selecting, customization, producing and delivery of these tailored products to a consumer.

**Claims 3, 9, and 22 are rejected under 35 USC 103 as being unpatentable over Direct Marketing and Forseth et al (US 2002 0004749 A1) and further in view of “King of Pop to deliver e – postcards to fans’ inboxes”; Sarah Heim; Adweek (Boston); September 3, 2000; Page 5(hereafter referred to as Adweek).**

The combination of Direct Marketing and Forseth, as previously noted discloses methods and system to have provided selecting, customization, production and delivery of absorbent paper products such as facial tissue or toilet tissue to a consumer.

The combination of Direct Marketing and Forseth does not teach a method and system to provide scented and scented absorbent paper products to a consumer.

However, Adweek does teach a method and system, which provides a paper product that can, include scent and unscented options - after receipt of desired selection from a consumer.

Regarding 3, Adweek discloses a method wherein the first feature is product scent, and wherein the options for the product scent include unscented (Page 1, line 17).

Regarding 9, Adweek discloses a method wherein providing includes providing the consumer with a list of scent options for the facial tissue product, and wherein receiving includes receiving from the consumer a selection of one of the scent options (Page 1, lines 16 - 17).

Regarding 22, Adweek discloses a system wherein said information includes information specifying a scent desired by the consumer, and wherein the production machine includes a fragancer for applying the scent to the absorbent paper product desired by the consumer (Page 1, lines 16 -17).

It would have been obvious to one ordinary skill in the art at the time of the invention to have provided the combination of Direct Marketing and Forseth with the method and system of Adweek to have included scented absorbent paper products such as facial tissue or toilet tissue - in order to expand the types of consumer product choices available for selecting, customization, producing and delivery of these tailored products to a consumer.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "Notebooks Made to Order" and "Winning the last mile of e – commerce" clearly demonstrate that the capability to provide methods and systems for consumers for selecting online customize products, produced and delivered has been well known in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 703.305.8230. The examiner can normally be reached on M-F 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703.308.1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7658 for regular communications and 703.308.3687 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.1113.

rer

October 30, 2002

  
JEFFREY A. SMITH  
PRIMARY EXAMINER